

Applicant(s): Van Arendonk, et al.
Serial No.: 09/932,101
Filed: August 17, 2001
For: OPTICAL COMPONENT AND METHOD OF MANUFACTURING SAME
Art Unit: 2839
Examiner: Prasad, Chandrika

NL000473

REMARKS/ARGUMENTS

Claims 1 through 15 are pending in the present application. Claims 11 and 14 have been amended.

The Office Action (1) objected to the drawings under 37 CFR 1.83(a) for purportedly failing to show every feature of the invention specified in the claims; (2) objected to the title of the invention as not being descriptive; (3) objected to the specification under 37 CFR 1.77(b) for not complying with the format suggested thereby; (4) rejected claims 11 and 14 under 35 U.S.C. 112, first paragraph, for purportedly failing to comply with the written description requirement; (5) rejected claims 1, 2, 3, 5, 8-10, 12, 13 and 15 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,369,717 to Attridge (hereafter "the Attridge reference"); and (6) rejected claims 4, 6-7, 11 and 14 under 35 U.S.C. 103(a) as being unpatentable in view of the Attridge reference.

Regarding item (1) identified above, applicants respectfully submit that, contrary to that which was suggested by the Action, the original drawings, in combination with the original specification, provide adequate disclosure to support the features defined in claims 11 and 14 (*See discussion of item (4) below*). Accordingly, reconsideration and withdrawal of the stated objection to the drawings are respectfully requested.

Regarding item (2) identified above, applicants respectfully submit that the title of the invention has been revised in an effort to accommodate the Examiner. However, applicants respectfully note that the title of the invention need only be descriptive of the claim scope asserted (*See discussion of item (4) below*). Accordingly, reconsideration and withdrawal of the stated objection to the title of the invention are respectfully requested.

Regarding item (3) identified above, applicants respectfully decline to amend the specification as suggested by 37 CFR 1.77(b) as such revisions are not required in accordance with MPEP 608.01(a).

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Regarding item (4) identified above, applicants respectfully note that an evaluation of a claim to determine if it meets the enablement requirement of 35 U.S.C. 112, first paragraph, cannot be based on the drawings alone but must include consideration of the scope of the claim as identified by the title and specification. "[T]he adequacy of the disclosure must be determined by reference to the scope asserted." *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 131 USPQ 413, 418 (D. Del. 1961). Further, the scope of enablement must only bear a "reasonable correlation" to the scope of the claims. *In re Fisher*, 427 F.2d 833, 839, 166 U.S.P.Q. 18, 24 (C.C.P.A. 1970). How a teaching is set forth, by specific example and/or broad terminology, is not important. *In re Marzocchi*, 439 F.2d 220, 223-24, 169 U.S.P.Q. 367, 370 (C.C.P.A. 1971). The only relevant concern should be whether the disclosure is commensurate with the scope of protection sought by the claims. *In re Moore*, 439 F.2d 1232, 1236, 169 U.S.P.Q. 236, 239 (C.C.P.A. 1971).

Applicants respectfully submit that, contrary to that which was suggested by the Action, the specification does in fact clearly describe and/or support that which is claimed by claims 11 and 14. For example, paragraph "[0033]" of the original specification as published reads "By varying the steepness of the walls 15 of the opening 14, the thickness of the layer of paraffin can be accurately adjusted." Applicants respectfully submit that the foregoing disclosure, in combination with the drawings (e.g., Figs. 1b and 1c), is more than enough to demonstrate to one skilled in the art that applicants had possession of the claimed invention at the time the original application was filed. Accordingly, reconsideration and withdrawal of the stated rejection of claims 11 and 14, and allowance thereof, are respectfully requested.

Regarding item (5) identified above, in furtherance of the response filed November 10, 2003, applicants respectfully maintain that claim 1 is patentable over the Attridge reference at least because the Attridge reference fails to disclose or suggest an optical component having a first element with "at least one opening" and "a light-emission surface".

The Action contends that "a holder comprising a base unit 8 and lid 9" (*See col. 3, lines 22-23*) is the same as a first element with at least one opening. Applicants respectfully submit that this contention

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is inaccurate and that “base 8”, alone, does not have “an opening” as suggested by the Action. Rather, referring to Fig. 2 of the Attridge reference, applicants respectfully submit that “base unit 8” and “lid 9” cooperate with “[a] glass window 10 [that] is mounted *between* base unit 8 and lid 9” so that a “small gap” exists between the edge of “optical wave guide 2” and the “glass window 10” (*See col. 3, lines 20-26*) (*emphasis added*). Further, according to the exemplary teachings subsequently disclosed by the Attridge reference, “A drop of index matching material such as a UV-curable optical adhesive ... is then applied so that the small gap fills by capillary action ... [t]he adhesive is then cured by exposure to ultraviolet light ...[and]... [t]he holder lid 9 is then attached to the base 8” (*See col. 3, lines 45-57 and col. 4, lines 1-2*).

In addition, applicants respectfully note that the Attridge reference clearly fails to disclose that the “holder comprising a base unit 8 and lid 9” has “a light-emission surface” as does the “first element” of claim 1. That is, although “glass window 10”, as purported by the Action, may have a “light-emission surface”, “glass window 10”, as disclosed by the Attridge reference, clearly lacks “at least one opening” as does the “first element” of claim 1.

Accordingly, based at least on the foregoing and in furtherance of the response filed November 10, 2003, reconsideration and withdrawal of the stated rejection of claim 1, and allowance thereof, are respectfully requested.

With respect to claims 2, 3, 5, 12, 13 and 15, which each depend directly from claim 1, applicants respectfully submit that each of these claims are patentable at least for the reason(s) identified above with respect to claim 1. Accordingly, reconsideration and withdrawal of the stated rejection of such claims, and allowance thereof, are respectfully requested.

With respect to claim 8, applicants respectfully submit that as claim 8 is directed to a method for manufacturing an optical component that has “a first element with at least one opening and a light-emission surface”, the reasons for patentability identified/discussed above with respect to claim 1 are equally applicable with respect to claim 8. Accordingly, at least for the reasons noted with respect to

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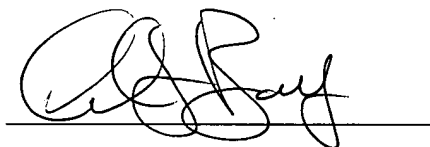
claim 1, applicants respectfully request reconsideration and withdrawal of the rejection of claim 8, and allowance thereof.

With respect to claims 9, 10 and 12, which each depend directly from claim 8, applicants likewise respectfully request reconsideration and withdrawal of the rejection of such claims, and allowance thereof, at least for the reasons previously noted with respect to claim 1.

Regarding item (6) identified above, applicants respectfully submit that with respect to rejected claims 4, 6, 7 and 14, all of which depend directly from claim 1, each claim is patentable over the Attridge reference for at least the reasons discussed with respect to claim 1 above. In addition, applicants respectfully submit that with respect to rejected claim 11, which depends directly from claim 8, such claim is likewise patentable over the Attridge reference for the reasons discussed with respect to claims 1 and 8. Accordingly, reconsideration and withdrawal of the rejection of claims 4, 6-7, 11 and 14, and allowance thereof, are respectfully requested.

In sum, it is respectfully submitted that the present claims are patentable over each of the cited references. Hence, this application is in condition for allowance. Accordingly, reconsideration and withdrawal of all rejections, and all objections of the claims, are respectfully requested.

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